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EXAMINER

CHANG, SABRINA A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/087,370

Applicant(s)

STEFANIK ET AL.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 – 8, 12, 14 –19, 23, 25 – 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker et al., US Patent Application Publication US 2003/0033243 A1. Baker discloses a digital content vending machine system and a method for using it. Digital content includes *computer programs*, videos and music [0003]. A digital content requester (such as a PDA) [0019] is wirelessly coupled to the content vending machine (software-dispensing ATM or kiosk) [0018]. Communications between the PDA and the software-dispensing machine can be sent via a Bluetooth network or through conventional infra-red, radio frequency and or other current or future wireless technologies [0018]. The software-dispensing machine can be connected to a remote content reservoir, that stores the computer programs, via a communications network or in the alternative the software-dispensing machine and the content reservoir can be compressed into one device, where the product offerings are stored on the software-dispensing machine [0024].

A user browses through the product offerings of the system using the software dispensing device (inherently comprising the listing of name, description and price of each product) [0033]. The machine contains any type of data and is advantageously adapted to dispense copy-sensitive

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data, such as copyrighted music, video or other forms of information [0034]. The user then selects a program for download, either using the PDA or through physical interaction with vending machine [0035].

The user renders payment using credit card, debit card, electronic funds transfer or any other acceptable means of payment [0036]. Once the payment has been verified, the content vending machine retrieves the requested software program, either stored locally or retrieved from the remote content reservoir [0038] and transmits the program wirelessly to the PDA [0040].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over over Baker et al., US Patent Application Publication US 2003/0033243 A1 in view of Suzuki et al. U.S. Patent No. 5,267,171.

Baker et al. does not explicitly disclose that in response to a user's selection of a program, the software-dispensing machine allows the user to preview the software.

Suzuki teaches a software-dispensing vending machine that enables a user to browse, purchase and download software. The machine has a display unit and a memory that stores programs for demonstration of each software product. Users can preview (emulate) a software product on the machine before choosing it for purchase.

It would have been obvious to modify the software-dispensing system of Baker et al. to include the ability to preview (emulate) a product on the machine, as taught by Suzuki, in order to ensure customer satisfaction.

Claims 9, 10, 11, 20 –22, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al., US Patent Application Publication US 2003/0033243 A1, in view of the article, “Hand-helds; Don’t Get into a Crunch: Prevention and a Backup Plan Can Save Your Data” (Kellner, Mark A. March 15, 2001).

Baker et al. does not explicitly disclose that:

- The information from the PDA is backed up onto the vending machine
- The system comprises restoring the backed up information from the vending machine onto a replacement PDA
- The system archives inactive software programs from the PDA onto the vending machine

PDA users typically use their personal, Internet-enabled computers to download desired software programs for their handhelds. Using the synchronization function, users then transfer these programs from their computer to their PDA. The extension of this process from a personal computer to a remotely located software-dispensing, ATM-like kiosk is an obvious one – as evidenced by Baker et al. – providing a PDA user with ubiquitous access to software products.

In the traditional model, users also typically synchronize existing information from the PDA for storage on their computer. Kellner teaches an online, web-based PDA data backup storage system. “FusionOne” offers a premium service that includes the ability to replicate a PDA’s data and program files online, creating ubiquitous access to the information (creating a backup, allowing for loading of the backup data on a replacement PDA, archiving inactive

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software on the system) for the express purpose of reducing the hassle and headache involved in replacing a PDA when it is lost, broken or stolen.

Just as Baker expanded the availability of software for a PDA user to download, it would have been obvious to one skilled in the art at the time to modify the system software distribution, as disclosed in Baker, to include remote back-up data storage capabilities, as taught in Kellner, in order to provide ubiquitous access to PDA information and decrease the hassles associated with a lost device.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Silk et al. discloses a system for distributing digital data. Silk does not disclose a software dispensing ATM machine.

Ortiz discloses a method and system for processing credit card data through a wireless hand held device. Ortiz does not disclose a software dispensing ATM machine.

Hitson et al. discloses a method of delivering multimedia content to a PDA. Hitson does not disclose a software dispensing ATM machine.

Wilf and Ruvio discloses a retail method over a wide are network. Ruvio does not disclose a software dispensing ATM machine.

Schroath and Christiansen disclose an apparatus and method for distributing software at a kiosk. Schroath does not disclose that this software can be requested by and downloaded to a PDA via a wireless communications system.

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Sweet discloses a kiosk for initializing and copying computer hard drives. Sweet does not disclose that the software interchange can be requested by and downloaded to a PDA via a wireless communications system.

Davidson discloses a personal movie storage module. Davidson does not disclose a software dispensing ATM machine.

Plain et al. discloses a method and apparatus for communicating data from a PDA over a network. Plain does not disclose a software dispensing ATM machine.


Johnson discloses a system and method for distributing files between an unsecure server and a client. Johnson does not disclose that a kiosk wirelessly downloads software to a requesting PDA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC

  
Jeffrey A. Smith  
Primary Examiner